

Appln. No. 10/609,427  
Amendment dated October 26, 2004  
Reply to Office Action mailed August 23, 2004

**REMARKS**

Reconsideration is respectfully requested.

Claims 1 through 18 remain in this application. Claims 19 and 20 have been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

**Paragraphs 1-9 of the Office Action**

Claims 1-4 and 7-8 have been rejected under 35 U.S.C. §102(b) as being anticipated by Gray (US 6,374,433).

It is submitted that the Gray reference does not disclose, teach or suggest "at least one panel assembly slidably coupling to said rail member of each of said support assemblies such that said panel assembly is positioned between said support assemblies, said panel assembly being slidably positionable along a length of said rail member of each of said support assemblies such that said panel assembly is adapted for covering a portion of the deck from the elements". The Gray reference teaches a movable hot tub cover structure that fails to teach the panel assembly being positioned between the rail members as required by the applicant's claims. The Gray reference teaches a rigid hot tub cover (12) that is used to represent the panel assembly of the applicant's claims with rails (42a,42b) of the Gray reference to represent the rail members of the applicant's claims. The Gray reference clearly shows the rigid hot tub cover (12) being positioned above the rails (42a,42b) and therefore fail to meet the requirements of the applicant's claims. Further, for claims to be anticipated by a reference that reference must describe every element of those claims as well as those elements must be arranged as is required by the claims as expressed in MPEP 2131 stated below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a

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single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. In *re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01."

Therefore, it is submitted that the Gray reference would not lead one to anticipate the combination of features as claimed by the applicant.

Withdrawal of the §103(a) rejection of claims 1-4 and 7-8 is therefore respectfully requested.

#### **Paragraphs 6 through 9 of the Office Action**

Claims 5 and 6 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Gray (US 6,374,433) in view of Ruffner (US 6,053,235).

The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art:

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In *re Fritch*, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732

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F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is submitted that the combination of Gray with Ruffner is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "at least one panel assembly slidably coupling to said rail member of each of said support assemblies such that said panel assembly is positioned between said support assemblies, said panel assembly being slidably positionable along a length of said rail member of each of said support assemblies such that said panel assembly is adapted for covering a portion of the deck from the elements". As discussed above, the Gray reference clearly fails to teach the panel assembly being positioned between the rail members as claimed by the applicant. Further, the Gray reference teaches the wheel being rotating around the axle portion and thus the axle is fixed to the support beams and therefore does not require sleeve members to be equipped to in the support beams to inhibit wear on the support beams by the axle as claimed by the applicant. Thus there is no motivation for the combination of the sleeve members of the Ruffner reference with the axle and support beams of the Gray reference as suggested in the Office Action. Therefore, it is submitted that the combination of the Gray reference with the Ruffner reference would not lead one to the combination of features as claimed by the applicant.

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person*." Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law

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which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)  
(emphasis in original).

Withdrawal of the §103(a) rejection of claims 5 and 6 is therefore respectfully requested.

**Paragraph 10 of the Office Action**

Paragraph 10 of the Office Action states that claims 9-17 would be allowable if written into independent form with the limitations of the base claim and any intervening claims.

New claims 19 and 20 have been added to vary the scope of the claims and clarify the present invention. All limitations are supported by the original disclosure including the specification, drawings and original claims. Claim 19 incorporates the limitations of claim 1 and allowable claim 9. Claim 20 incorporates the limitations of claim 10 and is dependent from claim 19. Therefore, no new matter has been added. The new claims are believed to be allowable.

**Paragraph 11 of the Office Action**

Claim 18 is allowed.


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**CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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Date: 11/1/04